

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 09/758,126

REMARKS

Claims 1-15 and 33-43 are pending in the application. By this Amendment, new claims 39-43 are added. Claims 1-15 and 33-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Palcic *et al.* (U.S. Patent No. 5,827, 190; hereinafter “Palcic”). Applicant submits the arguments below in traversal of the claim rejections.

Applicant submits that claims 1 and 2 are patentable because a *prima facie* case of obviousness was not established. Claim 1 recites:

A method of displaying a fluorescence image . . . comprising the steps of:

- i) making a judgment as to whether each of image areas embedded in the tissue condition image is *an abnormal light affected area, which has been affected by light having an intensity equal to at least a specified value, or a normal light detection area, which has been formed with light having an intensity lower than the specified value*, the judgment being made in accordance with at least one image, which is among the first fluorescence image, the second fluorescence image, and the reflected reference light image, and
- ii) displaying the abnormal light affected area in a form different from the normal light detection area.

Applicant submits that Palcic fails to teach, suggest, or provide motivation for, *inter alia*, making a judgment as to whether each of image areas embedded in the tissue condition image is an abnormal light affected area, which has been affected by light having an intensity equal to at least a specified value, or a normal light detection area, which has been formed with light having an intensity lower than the specified value, as recited in claims 1 and 2.

In the section of Palcic cited by the Examiner as supposedly disclosing the aforementioned elements of the claim, the reference merely discloses that “normal tissue appears

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in different colour from diseased tissue," (col. 2, lines 36-41) and that "autofluorescence intensity for normal tissue is substantially different from the autofluorescence intensity for diseased tissue" (col. 3, lines 9-13). Palcic, however, makes no mention of the normal light detection area, which has been formed with light having an intensity *lower* than the specified value, in the manner claimed.

Therefore, for at least the above reasons, claims 1 and 2 are patentable.

Claims 3-15 and 33-38, which depend from claim 1 or 2, are patentable for at least the reasons submitted for claims 1 and 2.

In addition, Applicant submits that claim 3 is patentable because Palcic fails to teach, suggest, or provide motivation for an apparatus wherein the specified value is determined in accordance with an intensity of the reflected reference light, which intensity indicates the presence of regularly reflected light, in the reflected reference light image. Rather, Palcic discloses the autofluorescence intensity for *both* normal and tumorous tissue.

Applicant submits that claim 33 is patentable because Palcic fails to teach, suggest, or provide motivation for, *inter alia*:

dividing values of the first fluorescence image by values of the second fluorescence image to obtain *chrominance signal components*; and
transforming values of the reflected reference light image into a *luminance signal component*.

Likewise, claim 36 is patentable because Palcic fails to teach, suggest, or provide motivation for, *inter alia*:

a color operation processing section receiving values of the first fluorescence image and values of the second fluorescence image to obtain to output *chrominance signal components*; and

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a luminance operation processing section receiving values of the regularly reflected light image to output a *luminance signal component*.

Nowhere in Palcic is there any mention of processing the autofluorescence image signals to output luminance or chrominance components.

New claims 39-43 are fully supported in the original disclosure and are patentable for at least the reason submitted for their base claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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